

REMARKS/ARGUMENTS

Favorable reconsideration of this application, as presently amended and in light of the following discussion, is respectfully requested.

Claims 1-9 are currently pending in the present application, Claims 1-4 and 7-9 having been amended. Claims 1-4 and 7-9 are amended to more clearly describe and distinctly claim the subject matter that Applicant regards as the invention. Applicant respectfully submits that no new matter is added.

In the outstanding Office Action, Claims 1-4 were rejected under 35 U.S.C. §103(a) as unpatentable over Fussganger (U.S. Patent No. 5,202,780) in view of Kunikane et al. (U.S. Patent No. 5,479,547, hereinafter Kunikane); Claim 5 was rejected under 35 U.S.C. §103(a) as unpatentable over Fussganger in view of Kunikane, and further in view of Rivoallan (U.S. Patent No. 6,130,974); Claim 6 was rejected under 35 U.S.C. §103(a) as unpatentable over Fussganger in view of Kunikane, and further in view of Ellison et al. (U.S. Patent No. 6,556,757); Claims 7 and 8 were rejected under 35 U.S.C. §103(a) as unpatentable over Fussganger in view of Feldman et al. (U.S. Patent No. 6,577,414, hereinafter Feldman), and further in view of Kunikane; and Claim 9 was rejected under 35 U.S.C. §103(a) as unpatentable over Fussganger in view of Schmack et al. (U.S. Patent No. 5,202,780, hereinafter Schmack), and further in view of Kunikane.

Applicant respectfully traverses the outstanding grounds of rejection because the outstanding Office Action fails to provide a *prima facie* case of obviousness by asserting prior art that, no matter how the prior art references are combined, does not teach every limitation of independent Claims 1 and 7-9, as amended.

To establish a *prima facie* case of obviousness, M.P.E.P. §2143 requires that three criteria must be met. First there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the

art, to modify the reference or to combine the references teachings. Second, there must be a reasonable expectation of success. Finally, the prior art references must teach or suggest all the claim elements.

In a non-limiting embodiment of the claimed invention, a PON system includes a central office unit that delivers a video signal and a data signal to a subscriber unit over a single fiber. Thus, an inexpensive subscriber unit can be provided to a subscriber who does not want to receive a video signal provided by the central office. Through this arrangement, the non-limiting embodiment of the claimed invention provides a low-priced subscriber unit to a subscriber who does not want to be distributed a video signal.<sup>1</sup>

Amended Claim 1 recites, *inter alia*,

subscriber unit comprising: a wavelength division  
multiplexer/demultiplexer configured to eliminate a particular  
wavelength signal.

The combination of Fussganger and Kunikane does not teach or suggest this element of Claim 1.

On the contrary, Fussganger describes an arrangement in which a VFE (remote distribution unit) is placed in the midway of the transmission line and multiple optical fibers are pulled into a subscriber, as shown in Fig. 1. As seen in Fig. 1, mux/demux 21 is not part of a subscriber unit. Fussganger describes that VFE 20 separates out a video signal and outputs the video signal to every subscriber who wants to be distributed a video signal. The subscriber unit of Fussganger does not eliminate a particular wavelength signal, and does not even include a multiplexer/demultiplexer.

Combining Kunikane with Fussganger does not teach or suggest a subscriber unit configured to eliminate a particular wavelength signal. Since Fussganger describes a VFE, which includes mux/demux 21, placed midway in the transmission line, combining

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<sup>1</sup> Specification, page 6, lines 20-26.

Fussganger and Kunikane does not teach or suggest “a subscription unit comprising: a wavelength division multiplexer/demultiplexer configured to eliminate a particular wavelength signal.”

In view of the above-noted distinctions, Applicant respectfully submits that Claim 1 (and Claims 2-6) patentably distinguish over Fussganger and Kunikane, alone or combination.

Claims 7 and 8 were rejected under 35 U.S.C. §103(a) as unpatentable over Fussganger in view of Feldman, and further in view of Kunikane. Claims 7 and 8 both recite “each of said subscriber units comprises a wavelength division multiplexer/demultiplexer configured to eliminate a particular wavelength signal.” The combination of Fussganger, Kunikane, and Feldman does not teach or suggest this element of Claims 7 and 8.

The combination of Fussganger and Kunikane does not teach or suggest this element of Claims 7 and 8 for at least the reasons stated for Claim 1. Feldman does not cure the deficiencies of Fussganger and Kunikane. Feldman was only cited to describe an optical amplifier, and does not teach or suggest the claimed “each of said subscriber units comprises a wavelength division multiplexer/demultiplexer configured to eliminate a particular wavelength signal.”

In view of the above-noted distinctions, Applicant respectfully submits that Claims 7 and 8 patentably distinguish over Fussganger, Kunikane, and Feldman, alone or in combination.

Claim 9 was rejected under 35 U.S.C. §103(a) as unpatentable over Fussganger in view of Schmack, and further in view of Kunikane. Claim 9 recites “a first wavelength division multiplexer/demultiplexer configured to demultiplex the video signals and signals other than the video signal; and a second wavelength division multiplexer/demultiplexer

configured to eliminate a particular wavelength signal.” The combination of Fussganger, Kunikane, and Feldman does not teach or suggest this element of Claim 9.

The combination of Fussganger and Kunikane does not teach or suggest this element of Claim 9 for at least the reasons stated for Claim 1. Schmack does not cure the deficiencies of Fussganger and Kunikane.

Combining Schmack with Fussganger and Kunikane does not teach or suggest a subscriber unit that eliminates a particular wavelength signal. Since Fussganger describes a VFE, which includes mux/demux 21, placed midway in the transmission line, combining Fussganger, Schmack and Kunikane does not teach or suggest a subscription unit including first and second wavelength division multiplexers/demultiplexers configured to eliminate a particular wavelength signal. The subscriber unit of Fussganger does not eliminate a particular wavelength signal, and does not even include a multiplexer/demultiplexer. The demultiplexer in Fig. 2 of Schmack does not eliminate a particular wavelength signal, but rather demultiplexes a received signal into broadband channels.<sup>2</sup>

In view of the above-noted distinctions, Applicant respectfully submits that Claim 9 patentably distinguishes over Fussganger, Kunikane, and Schmack, alone or in combination.

Furthermore, the outstanding rejection does little more than attempt to show that parts of the inventive combination of Claims 1 and 7-9 were individually known in other arts and to suggest that such a showing is all that is necessary to establish a valid case of *prima face* obviousness. The PTO reviewing court recently reviewed such a rationale and dismissed it in *In re Rouffet*, 149 F. 3d 1350, 1357, 47 USPQ2d 1453, 1457-58 (Fed. Cir. 1998) as follows:

As this court has stated, "virtually all [inventions] are combinations of old elements." *Environmental Designs, Ltd. v. Union Oil Co.*, 713 F.2d 693, 698, 218 USPQ 865, 870 (Fed. Cir. 1983); see also *Richdel, Inc. v. Sunspool Corp.*, 714 F.2d 1573, 1579-80, 219 USPQ 8, 12 (Fed. Cir. 1983) ("Most, if not all, inventions are combinations and mostly of old elements."). Therefore an examiner may often find every element of a claimed invention in the prior art. If

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<sup>2</sup> Schmack, col. 2, lines 65-67.

identification of each claimed element in the prior art were sufficient to negate patentability, very few patents would ever issue. Furthermore, rejecting patents solely by finding prior art corollaries for the claimed elements would permit an examiner to use the claimed invention itself as a blueprint for piecing together elements in the prior art to defeat the patentability of the claimed invention. Such an approach would be "an illogical and inappropriate process by which to determine patentability." *Sensonics, Inc. v. Aerosonic Corp.*, 81 F.3d 1566, 1570, 38 USPQ2d 1551, 1554 (Fed. Cir. 1996). To prevent the use of hindsight based on the invention to defeat patentability of the invention, this court requires the examiner to show a motivation to combine the references that create the case of obviousness. In other words, the examiner must show reasons that the skilled artisan, confronted with the same problems as the inventor and with no knowledge of the claimed invention, would select the elements from the cited prior art references for combination in the manner claimed. [emphasis added.]

There has been no such showing of those required reasons made in the rejection.

Finally, it is respectfully requested that the references submitted in the IDS filed February 21, 2002 be considered on the record, and that the Examiner send the undersigned an initialed PTO-1449 form to that effect.

Consequently, in light of the above discussion and in view of the present amendment, the present application is believed to be in condition for allowance and an early and favorable action to that effect is respectfully requested.

Respectfully submitted,

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